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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,198	04/24/2001	Hitoshi Matsui	P/2617-19	5833
7590	02/09/2004		EXAMINER	
Steven I Weisburd DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 Avenue Of the Americas New York, NY 10036-2714			PHU, SANH D	
			ART UNIT	PAPER NUMBER
			2682	5

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/841,198	MATSUI, HITOSHI	
	Examiner Sanh D Phu	Art Unit 2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3 &amp; 4</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The IDS filed 1/23/2003 and 04/16/2003 have been considered and recorded in the file.

### *Drawings*

2. The Fig. 1 is objected to under 37 CFR 1.83(a) because they fail to show an “automobile” and a “portable terminal” as recited in claim 1 and described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing.

MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

The objection to the drawings will not be held in abeyance.

### *Claim Rejections – 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is recites the limitation "the data delivering system as set forth in claim 5" is insufficient antecedent basis for the claim. It appears that claim 5 depends on claim 1; it does not depend on claim 5. Claim 6, as depended on claim 5, is therefore also rejected.

*Claim Rejections – 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1–18 are rejected under 35 U.S.C. 102(b) as being anticipated by Treyz et al (6,526,335).

Regarding to claim 1, see Fig. 1, 2 and 3, Treyz et al discloses a data

delivery system

(a) drive-through facilities in which an automobile including a portable terminal having a function of making radio communication parks (see col. 10, line 23 to col. 11, line 20);

(b) a communication device which makes radio communication with said portable terminal when said automobile parks in said drive-through facilities (see col. 10, line 23 to col. 11, line 20); and

(c) a data delivery unit which receives a request of delivering data to said portable terminal, transmitted from said portable terminal through said communication device, and transmits requested data to said portable terminal through said communication device (see col. 10, line 23 to col. 11, line 20).

Regarding to claim 2, see Fig. 1, 2 and 3, Treyz et al discloses that a communication device makes radio communication with said portable terminal through small-powered radio wave (blue-tooth) or weak radio wave (see col. 11, lines 23-37).

Regarding to claim 3, see Fig. 1, 2 and 3, Treyz et al discloses data

stored in said data delivery unit can be updated through Internet (see col. 10, line 23 to col. 11, line 20).

Regarding to claim 4, see Fig. 1, 2 and 3, Treyz et al discloses that data delivery unit is comprised of:

(c1) a memory (16, 18, 32) (which is a portable or a laptop computer that inherently has a memory) storing various data therein (see col. 10, line 23 to col. 11, line 20); and

(c2) a controller (16,18,32) which receives a request of delivering data to a portable terminal equipped in an automobile parking in drive-through facilities, reads requested data out of said memory, and transmits the thus read-out data to said portable terminal (see col. 10, line 23 to col. 11, line 20).

Regarding to claim 5, see Fig. 1 &2. Treyz et al discloses that said controller receives data through internet (30,32) (via 42 path that connects 16,18,32,30), and stores the thus received data into said memory (see Fig. 1, col. 10, line 39-54).

Regarding to claim 6, Treyz et al discloses that said controller carries out

accounting, based on an identification number transmitted from said portable terminal, after transmitting said data to said portable terminal (see Fig. 16, col. 22, lines 46 to col. 23, line 21).

Regarding to claim 7 and 10. Treyz et al discloses a method of delivering data, comprising the steps of:

step (a) transmitting a request of delivering data to a portable terminal equipped in an automobile parking in drive-through facilities, to a data delivery unit, said step (a) being carried out by said automobile (see col. 10, line 23 to col. 11, line 20);

step (b) reading data requested by said portable terminal, out of a memory, said step (b) being carried out by said data delivery unit (see col. 10, line 23 to col. 11, line 20); and

step (c) transmitting data read out in said step (b) to said portable terminal, said step (c) being carried out by said data delivery unit (see col. 10, line 23 to col. 11, line 20).

Regarding to claim 8 and 11, Treyz et al discloses that a method

comprising the step of (d) downloading received data in a memory equipped in said portable terminal, said step (d) being carried out by said portable terminal (see col. 10, line 23 to col. 11, line 20).

Regarding to claim 9 and 12, Treyz et al discloses a method wherein said portable terminal makes radio communication with said data delivery unit through a communication device in small-powered radio wave or weak radio wave (see col.11, lines 24-37).

Regarding to claim 13 and 16, Treyz et al discloses a recording medium readable by a computer, storing a program therein for causing a computer to act as a data delivery unit, said data delivery unit comprising:

for (a) a memory (16,18,32) (which is portable or laptop computer that inherently has a memory) storing various data therein (see col. 10, line 23 to col. 11, line 20); and

for (b) a controller (16,18,32) which receives a request of delivering data to a portable terminal equipped in an automobile parking in drive-through facilities, reads requested data out of said memory, and transmits the thus read-out data to said portable terminal (see col. 10, line 23 to col. 11, line 20).

Regarding to claim 14 and 17, Treyz et al discloses the recording medium wherein said controller receives data through internet (30,32) (via 42 path that connects 16,18,32,30), and stores the thus received data into said memory (see col. 10, line 23 to col. 11, line 20).

Regarding to claim 15 and 18, see Fig. 16, Treyz et al discloses the recording medium wherein said controller carries out accounting, based on an identification number transmitted from said portable terminal, after transmitting said data to said portable terminal (see col. 22,lines 46 to col. 23, line 21).

*Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D Phu whose telephone number is (703) 305-8635. The examiner can normally be reached on 8:00-16:30.

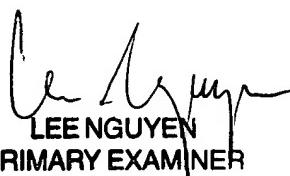
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-301-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2682

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-8635.

Sanh D. Phu  
Examiner  
Art Unit 2682

SP



LEE NGUYEN  
PRIMARY EXAMINER